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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,067	08/20/2001	Steve Brandstetter	P/94-1	6703

7590 09/03/2010

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EXAMINER	
COBURN, CORBETT B	

ART UNIT	PAPER NUMBER
3714	

MAIL DATE	DELIVERY MODE
09/03/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/933,067	BRANDSTETTER ET AL.	
	Examiner	Art Unit	
	Corbett B. Coburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 August 2010*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9,11-13,16,18 and 21-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9, 11-13, 16, 18 & 21-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. It appears that in Case Number A571641 in the District Court of Clark County, Nevada, Applicant has alleged (on page 25 of his complaint) that several parties have misappropriated his trade secrets in connection with this invention. It follows from this that a rejection under 35 U.S.C. §112, 1st paragraph is appropriate since, if Applicant has maintained valuable trade secrets in connection with the making or use of this invention, then he has not disclosed the best mode of carrying out his invention as required by the statute. Therefore, Claims 1-9, 11-13, 16, 18 & 21-23 are rejected under 35 U.S.C. § 112, 1st paragraph as failing to comply with the best mode requirement.

3. Applicant was given an opportunity to clarify the record concerning this matter, but failed to do so. This leaves the Examiner with no choice but to make the foregoing rejections.

4. Applicant is again reminded of his continuing obligation to provide any information in Applicant's possession that is material to patentability – including any information concerning this rejection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-6, 9, 12, 16, 21 & 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okuniewicz (US Patent Number 6,585,589) in view of Quinn (US Patent Number 3,688,276).

Claim 1: Okuniewicz teaches device for paying out a bonus (Col 1, 43-46) to a player playing a gaming machine. (Fig 1) There is a gaming machine (Slot Machine). The gaming machine obviously contains a processor for implementing a game of chance (including video poker) and paying off according to matching symbols. (Col 1, 20) There is a dispensing unit (Lottery Terminal). Since Okuniewicz teaches that the dispensing unit may dispense a ticket when a preset amount of coins are inserted (Col 3, 46-53), there must be a numeric counter for counting the number of coins placed in said gaming machine that counts coins until a ticket is generated. Okuniewicz does not teach visually displaying to the player the number of coins needed to generate a ticket or the number of coins inserted by the player. Nor does Okuniewicz teach resetting the counted coins to zero once a ticket is generated. These are common functions on virtually any modern vending machine.

Quinn, which is also a lottery ticket dispenser, teaches visually displaying to the player the number of coins needed to generate a ticket and the number of coins inserted by the player as well as resetting the counted coins to zero once a ticket is generated. (Fig 1) Such a visible meter allows the player to know how much money he must insert and how much money he has inserted. Clearing the counter lets the player know that if he wants another ticket, he has to put in more money. These features add to user

convenience and are, as previously pointed out, extremely well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Okuniewicz in view of Quinn to visually display to the player the number of coins needed to generate a ticket and the number of coins inserted by the player as well as to reset the counted coins to zero once a ticket is generated in order to add to player convenience.

Furthermore, a combination of prior art elements, each performing their normal functions in a predictable manner to yield a predictable result is obvious. In this case, Okuniewicz teaches a slot machine that dispenses a lottery ticket when a preset number of coins have been inserted into the machine. Quinn, which also dispenses a lottery ticket when a preset number of coins have been inserted into the machine, has a meter that displays the number of coins inserted and the number of coins remaining prior to dispensing a ticket. In the combination, Okuniewicz's slot machine/ticket dispenser works in its accustomed manner. Quinn's lottery ticket dispenser/coin meter work in its accustomed manner. The combination of Okuniewicz and Quinn yield predictable results. The combination is therefore obvious.

Regarding the ticket being supplemental to a gaming award, see the underlined portion of the rejection above. Regarding the numeric counter continuing to count (presumably coins) from player to player until the dispensing unit dispenses a ticket, Okuniewicz has no mechanism for determining who deposits a coin. Neither does Quinn. Clearly, since neither device can determine when one player leaves & another player arrives, the numeric counters in both would continue to count coins until a ticket is

dispensed.

Claims 2-4: Okuniewicz teaches that the dispensing unit may be a retrofit unit for a slot machine (Col 3, 1-4). Okuniewicz teaches that the dispensing unit could be attached to the gaming machine externally (i.e., side-mounted) or mounted internally. (Col 4, 63-66)

Claim 5: The gaming machine may include video poker machines (Col 3, 36-42). Video bingo games and video keno games are disclosed as equivalents.

Claim 6: The dispensing unit is a self-contained unit that does not affect play or outcome of said gaming machine. (Col 4, 35-43)

Claim 9: Okuniewicz dispenses lottery tickets. (Abstract)

Claim 12: Claim 12 is a combination of claims 1, 5, & 9 with the addition of holding a drawing to determine a winner of said ticket – which is taught by Okuniewicz.

Claim 16: Okuniewicz teaches the lottery ticket may be for the Big Game. In the Big Game, a bonus prize is generated from a percentage of total coins placed into all participating gaming machines (i.e., a percentage of money used to buy game tickets).

Claim 21: Since Okuniewicz does not disclose a bill validator, it does not disclose counting on dollar bills put into a bill validator. Furthermore, it teaches counting on "coin in". Thus it teaches counting coins in instead of credits paid. Okuniewicz makes it clear that any event on a slot machine may be used to trigger issuance of a lottery ticket. In the final analysis, the choice of trigger is a matter of design choice that would lead to predictable results.

Claim 23: Okuniewicz & Quinn teach the invention substantially as claimed (see claim 1), but fail to teach a voice signal when a coin is deposited. Applicant has disclosed

visual & voice signals as being equivalent. (See paragraph 0018) Therefore it is obvious to substitute the claimed audio recording for the visual counter of Quinn. Furthermore, it is well known to provide voice indications for the visually impaired. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Okuniewicz & Quinn to include a voice counter to count the number of coins deposited since substitution of known equivalents is considered obvious. Furthermore, it would provide information to the blind.

7. Claims 7, 8, 11, 13 & 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okuniewicz and Quinn as applied to claim 1, 12 above, and further in view of Castellano et al. (US Patent Number 5,477952).

Claims 7, 13: Okuniewicz and Quinn teach the invention substantially as claimed. Both contain coin counters, but do not give details of the operation thereof. Okuniewicz bonuses a player based on number of coins played (Col 3, 51) but does not teach that the numeric counter counts coin pulses off of the gaming machine's hard meter. Castellano teaches the method of operation of the coin counters. Castellano teaches that the numeric counter (12) counts coin pulses off of the gaming machine's hard meter (52). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Okuniewicz and Quinn in view of Castellano to have the numeric counter count coin pulses off of the gaming machine's hard meter in order to carry out Okuniewicz and Quinn's suggestion to count the coins entered by the player.

Claim 8: Okuniewicz and Quinn teach the invention substantially as claimed. Neither specifically discloses that the numeric counter can count various coin denominations.

Castellano specifically teaches discloses that the numeric counter can count various coin denominations. (Fig 1, 21-24) Allowing players to use more than one denomination makes it convenient for the player to put more money in the slot machine. This increases profits. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Okuniewicz and Quinn in view of Castellano to have the numeric counter can count various coin denominations in order to make it convenient for the player to put more money in the slot machine.

Claims 11, 18: Okuniewicz teaches that the benefit of the device is the ability to change the criteria for generating a ticket. (Col 3, 1-9) The LIB is a remote unit (i.e., a separate module) for changing the number of coins necessary to generate said ticket.

8. Claim 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Okuniewicz & Quinn as applied to claim 1 above, and further in view of Harlick (US Patent Number 4,636,951).

Claim 22: Okuniewicz & Quinn teach the invention substantially as claimed, but fail to teach networking the gaming machines such that a combination of devices requires a certain number of coins before a ticket is issued. Okuniewicz teaches that a ticket may be issued when a certain number of coins are deposited to a machine. Harlick teaches networking a number of machines in such a way that a player may move from machine to machine while maintaining the same credit state. (Col 1, 62 & Col 2, 65-66) This allows the player to move to a different machine if there is a machine malfunction without any penalty. Clearly, applying Harlick's teaching to Okuniewicz & Quinn would yield a networked system where a combination of devices require a certain coin in before issuing

a ticket.–For instance, if a player places 9 coins in a first machine (where the trigger is 10 coins), and moves to a second machine, the system would issue a lottery ticket when the player puts the 10^{th} coin into the 2^{nd} machine.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Okuniewicz & Quinn in view of Harlick to have a network of gaming machines wherein a combination of devices require a certain number of coins before a ticket is dispensed.

Response to Arguments

9. Applicant's arguments filed 24 August 2010 have been fully considered but they are not persuasive.

10. Applicant is repeating arguments that have been answered over and over again. Constant repetition does not make the arguments more persuasive. As Examiner has explained numerous times, the randomness discussed by Okuniewicz is the randomness of the lottery drawing – not necessarily the randomness of issuing a ticket.

11. Okuniewicz says that the ticket can be issued when a certain number of coins are paid into the machine. This is absolutely crystal clear. The reference says that in black and white. Examiner cannot ignore the clear language of the reference. While Okuniewicz may generate a lottery ticket based on some random occurrence in the game, it may also generate it based on a non-random factor (i.e., the number of coins deposited). Arguing about the definition of random will not change what the reference says. Clearly, if Okuniewicz issues a ticket after a certain number of coins are deposited, then it does not do so randomly.

12. Regarding the flying car "argument", if Applicant can show that the combination of Okuniewicz & Quinn would produce unexpected results, or that such a combination would be beyond the level of ordinary skill, then evidence to support that contention will certainly be considered. Examiner is constrained to apply the law as set forth in the statutes & the relevant court decisions. Applicant is referred to *KSR Int'l Co. v. Teleflex Inc.,* 550 US 398 (2007) for more information regarding the obviousness of combinations of elements performing their normal function in their normal manner to yield predictable results.

13. The failure to set forth the best mode for the making and operation of Applicant's invention & the withholding of information material to patentability are serious issues. Deliberately doing so might be considered to be fraud upon the Patent Office. Applicant was given an opportunity to remedy any inadvertent mistakes in this regard in the last Office Action,

but failed to do so. Examiner trusts that this is an inadvertent error that will be remedied in Applicant's response to this Office Action. However, Applicant's failure to address this matter has led to the issuance of a rejection of the claims. In order to be responsive to this Office Action, any response must fully address this issue. Failure to address this issue will be considered deliberately non-responsive.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Corbett B. Coburn/
Primary Examiner
Art Unit 3714